

REMARKS / ARGUMENTS**Status of claims**

Claim 18 was the sole claim previously pending in this application. With the present amendment new claims 19 - 84 are being presented for consideration by the Examiner.

Rejection for obviousness-type double-patenting

In the Office Action, the Examiner rejected claim 18 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claim 6 of U.S. Patent No. 6,285,987 (the "'987 patent"), in view of Angles et al., U.S. Patent No. 5,933,811, and Brown, U.S. Patent No. 5,794,219.

A Terminal Disclaimer over the '987 patent is concurrently being filed with this reply, obviating any non-statutory double-patenting rejections in this application over the '987 patent. The Examiner is respectfully requested to acknowledge acceptance of the Terminal Disclaimer in a future Office Action.

Rejection under 35 U.S.C § 103

The Examiner rejected claim 18 as being unpatentable under 35 U.S.C. § 103(a) over Angles et al., U.S. Patent No. 5,933,811 ("Angles"), in view of Davis et al., U.S. Pre-grant Patent Appl. Pub. No. 2001/0042064 B1 ("Davis").

The present application claims priority to the '987 patent, having a filing date of January 22, 1997. All claims currently pending in this application find adequate support in the '987 patent. Without an effective date to the '987 patent, none of the presently pending claims would be patentable.

The Examiner does not dispute the priority claim, but contends that "Angles and Davis [have] priority date[s] before 1/22/997". Office Action p. 6.

Applicant respectfully disagrees. Davis is not prior art to this application. Davis' earliest priority date is May 28, 1999; more than two years after the priority date of this application. As such, it is respectfully requested that the rejection under § 103 be withdrawn.

Reply to "Non-Final Office Action"

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March 11, 2008

Rescindment of statements in view of *Hakim v. Canon*

Applicant expressly rescinds and withdraws all statements, if any, made in the prosecution of the '987 patent, the parent of the present application, including in an interference proceeding¹, that pertain to the present application with regards the scope of the invention and reasons for patentability over the prior art. This express rescindment is required by a recent decision of the Federal Circuit, *Hakim v. Canon Avent Group*, Case no. 2005-1398 ("Although a disclaimer made during prosecution can be rescinded, permitting recapture of the disclaimed scope, the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited", Slip Op. p. 7). The rescindment of such statements is to the sole effect as if such statements were never made. The Examiner may as a result decide to revisit any issues of patentability. Applicant reserves the right to again argue and/or make such statements in arguing the patentability of the present application.

Inventorship

The sole inventor currently named in the present application is Mr. Jonathan Dorfman. Mr. Dorfman is the inventor of the original claims, as well as the claims presented by the amendments of 12-23-2003, 7-12-2004, 12-21-2004, 7-7-2005 and 2-22-2006.

On November 19, 2006, the presented claim were amended so as to entitle all claims to claim priority to the '987 patent. Likewise the claims currently pending are all entitled to claim priority to the '987 patent. As a result of the amendments and the claim of priority to the '987 patent, Mr. Dorfman is no longer a properly named inventor. Rather the proper inventor is Mr. David W. Roth, one of the inventors of the '987 patent. Although the '987 patent names another inventor, Mr. Dylan F. Salisbury, it appears that Mr. Roth should be the sole named inventor for the claims currently pending in the present application.

¹ The "Information Disclosure Statement" filed on December 14, 2007, includes references EA to ES, which are copies of papers filed in Interference No. 104,443, relating to the '987 patent. The Examiner's attention is drawn to the fact that "Preliminary Motions 1- 4", filed by Applicant in the aforesaid Interference proceeding were withdrawn by Applicant prior to the conclusion of the Interference proceeding. Thus, even without the instant rescindment, any statements made in the Preliminary Motions, whether applicable or not to the present application, should be deemed withdrawn.

The sole inventorship of Mr. Roth is evidenced by a specification he authored having a revision date of July 14, 1996 (the "July 1996 specification"). The specification was submitted in the IDS of December 14, 2007, as part of Citation EA, which is a copy of a submission in Interference No. 104,443 relating to the '987 patent, entitled "*Roth's Transmittal of Preliminary Statement and Notice*".

Mr. Salisbury recently confirmed that he joined Mr. Roth's development team in August 1996. Thus, it appears that Mr. Salisbury did not contribute to any of the inventive concepts included in the July 1996 specification. It appears that all of the pending claims find support for "conception" in the July 1996 specification. As such, Mr. Roth should be the only named of the present application.

Applicant will be filing a petition to change inventorship of the present application to remove Mr. Dorfman as inventor, and in place add Mr. Roth as inventor.

The Examiner is requested to carefully review the inventorship issue as noted above.

Related Applications

The present application is related to Appl. No. 10/655,549, an application for reissue of the '987 patent and Appl. No. 09/216,206 ("206 application"), a continuation-in-part of the '987 patent. Both of said related applications are currently undergoing active examination. A response to a non-final rejection has recently been filed in the '206 application. The present application is also related to a number of continuation applications of the '206 application and/or the present application, for which the examination process has yet to begin.

Claim Construction

The present application includes a number of independent claims and dependent claims. Each dependent claim refers to either an independent claim or another dependent claim. Applicant hereby states its express intent that each dependent claim should be construed and attributed meaning as having at least one additional limitation or element not present in the claim to which it refers. Likewise, the claim to which each dependent claim refers is to be construed and attributed meaning as being broader than such dependent claim.

For example, several dependent claims include the limitation “wherein the request for content is caused by a reference in a webpage”. Hence, the claims to which such dependent claims refer are to be construed broadly, i.e. as not being limited to the request for content being caused by a reference in the webpage; rather the advertisement may be inserted into the webpage using other mechanisms, such as server side scripts (e.g CGI, PHP, etc.). The advertisement may for example be in the form of a text advertisement (stored in a database), which is incorporated at the server-side into the script of a web page served to the browser (in which cases the request for content would be responded to by serving the general web page content together with the advertisement.)

Claims 19 and 52 recite: “a monetary amount that an advertiser associated with the each submitted bid is *willing* to pay”. This means that the “amount” is what the advertiser is *willing* to pay. It should therefore be understood that the system could optionally discount the *actual* amount the advertiser pays in the event the bid is selected and the specific event occurs. The discount on behalf of the advertiser may take into account various factors. The system may discount the actual amount to an increment above an amount of another submitted bid. The system may also discount the amount based on the quality of the web page on which the selected advertisement is displayed.

The phrase “each set of bidding parameters being associated with at least one of the plurality of advertisements” means that optionally more than one advertisement may be associated with a set of bidding parameters. The bidding parameters may indicate that the system is to display the advertisements in rotation each time a particular viewer who meets criteria of the bidding parameters is encountered (see specification, paragraph 123). Alternatively, other criteria may be utilized for determining when to display which of the associated advertisements.

The term “specific event occurs” means that a specific event, such as a display or click-through occurs to an advertisement associated with the bid. The term “same respective event”, means that the event that triggers payment is a same respective event for all bids. For example, the same respective event may be a serving of respective advertisements associated with the bids. Alternatively the same respective event may be a click-through on respective advertisements

associated with the bids. Alternatively, the same event is a 2-minute display of respective advertisements associated with the bids (However, a 1-minute display of an associated advertisement for one bid and a 2-minute display of an associated advertisement of a second bid, are essentially not a "same respective event").

The phrase "*wherein the selection of the selected bid is based on the selected bid being determined in the computer system as having a highest beneficial value over respective beneficial values of other submitted bids*" means that the selected bid is determined by the system to result or expecting to result in the most revenue from the corresponding advertiser, to the system operator, to the web site owner and/or other beneficiaries of the underlying advertising opportunity. The claim term should be construed to encompass embodiments wherein the system determines the beneficial value of a bid by taking into account the probability that the event that triggers payment of the monetary amount would occur. When the specific event is a serving of an advertisement to a browser, then the bid with the highest beneficial value will generally be determined by the system as corresponding to the bid associated with the highest monetary amount.

It should be understood that the claims are to be construed such that the system does not necessarily collect and maintain information about viewers, web pages and websites. Information about viewers, web pages and/or websites may be determined in real time. Nor should the claims be limited as to the manner and form of maintaining the advertisements. Thus, each advertisement may be stored in an individual file, or alternatively multiple advertisements may be maintained in a database. It should further be understood that the claims are to be construed such that a single request for content may be indicative of one or more advertising opportunities. Multiple advertising opportunities, for multiple advertisement spaces, may be available on a single web page, which may all be invoked by a single request for content that indicates the multiple advertising opportunities to the system.

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CONCLUSION

In view of the foregoing arguments, it is respectfully urged that each of the pending claims is in condition of allowance. Should the Examiner feel that an interview would be helpful in advancing the present application, the Examiner is respectfully invited to contact the undersigned at the number listed below in order to schedule an interview.

Dated: March 11, 2008

Respectfully submitted,

Signature: /Benzion A. Wachsman/

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*A statement under 37 CFR § 3.73(b) is attached

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